

Attorney Docket: 042846-0313440

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE PATENT : Andrew ROUSE *et al.*
APPLICATION OF :
SERIAL NO. : 09/750,320
FILING DATE : December 29, 2000
ART UNIT : 2618
EXAMINER : YUWEN PAN
FOR : SYSTEM AND METHOD FOR PROVIDING WIRELESS DEVICE ACCESS

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Mail Stop APPEAL BRIEF - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action mailed **September 8, 2008** ("the Office Action"), and further to the Notice of Appeal filed herewith, Appellants respectfully submit an Appeal Brief pursuant to 37 C.F.R. § 41.37.

The Director is authorized to charge the \$540.00 fee for filing an Appeal Brief pursuant to 37 C.F.R. § 41.20(b)(2). The Director is further authorized to charge any additional fees that may be due, or credit any overpayment of same to Deposit Account No. 033975 (**Ref. No. 042846-0313440**).

REQUIREMENTS OF 37 C.F.R. §41.37

I. 37 C.F.R. § 41.37(c)(1)(i) – REAL PARTY IN INTEREST

The real party in interest is International Business Machines Corporation.

II. 37 C.F.R. § 41.37(c)(1)(ii) – RELATED APPEALS AND INTERFERENCES

There are no related appeals and/or interferences.

III. 37 C.F.R. § 41.37(c)(1)(iii) – STATUS OF CLAIMS

Pending: Claims 21, 22, 24-30, 32-39, and 41-44 are pending.

Cancelled: Claims 1-20, 23, 31, and 40 have been cancelled without prejudice or disclaimer.

Rejected: Claims 21, 22, 24-30, 32-39, and 41-44 stand rejected.

Allowed: No claims have been allowed.

On Appeal: The rejections of claims 21, 22, 24-30, 32-39, and 41-44 are appealed.

IV. 37 C.F.R. § 41.37(c)(1)(iv) – STATUS OF AMENDMENTS

No amendments have been entered subsequent to the mailing of the Office Action.

V. **37 C.F.R. § 41.37(c)(1)(v) – SUMMARY OF CLAIMED SUBJECT MATTER**

A. **INDEPENDENT CLAIMS**

The implementation of wireless devices to access information is generally known. For example, at the time of the invention, files were typically transmitted to and stored on a wireless device, and a user would be enabled to access/manipulate the locally stored files and interact with the information contained therein through software that was also stored on the device. As another example, information generated for display on a desktop terminal could be transmitted to a wireless device, which could then display the information as it was intended to be displayed on the desktop terminal, or the wireless device could further format the information before displaying it. Generally, these solutions for accessing information on a wireless device were resource intensive because they required a relatively large amount of processing and/or storage resources of the wireless device to be dedicated to opening/manipulating files stored locally on the wireless device, or dedicated to reformatting display information originally generated for a desktop terminal.

One aspect of the invention of the instant application enables display information generated by applications actions to files executed on a server to be transmitted to a wireless client device such that the display information has been formatted on the server for display on the wireless client device prior to transmission to the wireless client device. This may reduce the amount of processing and/or storage required to convey the information to a user on the wireless client device. In some embodiments, the formatting of the information on the server may be customized specifically for one or both of the wireless client device and/or the user of the wireless client device.

1. **Claim 21**

One aspect of the invention relates to a method for enabling a wireless client device to communicate with at least one server having one or more applications residing thereon. See, e.g., the specification, pg. 7 line 18-pg. 8 line 4. In some embodiments, the method may comprise enabling the wireless client device to select an application residing on the at least one server (see, e.g., *id.* at pg. 12 line 19-pg. 13 line 8); enabling

the wireless client device to select at least one application action associated with the selected application residing on the at least one server (*see, e.g., id.* at pg. 12 line 19-pg. 13 line 8); executing the at least one selected application action on the at least one server (*see, e.g., id.* at pg. 12, lines 19-21), the application action comprising one or more of opening at least one file within the server, closing at least one file within the server, editing at least one file within the server, or searching at least one file within the server (*see, e.g., id.* at pg. 13, lines 2-8); formatting at least one application output associated with the at least one selected application actions based on a profile of the wireless client device and a user selection of one or more fields associated with the at least one file (*see, e.g., id.* at pg. 31 line 15-pg. 32 line 2); and transmitting the formatted at least one application output to the wireless client device (*see, e.g., id.* at pg 12, lines 19-21).

2. Claim 28

Another aspect of the invention relates to a wireless communication system. In some embodiments, the system comprises at least one server and at least one wireless client device. The at least one server has one or more applications. *See, e.g., id.* at pg. 11, lines 5 and 6. In some embodiments, the at least one wireless client device comprises a views/folders module, a default and custom actions module, and a forms module. The views/folders module may enable the at least one wireless client device to display options associated with a selected application residing on the at least one server. *See, e.g., id.* at pg. 27, lines 7-13. The default and custom actions module may enable the at least one wireless client device to select at least one application action associated with the selected application to be executed on the at least one server. *See, e.g., id.* at pg. 28, lines 7-13. The application action may comprise one or more of opening at least one file within the server, closing at least one file within the server, editing at least one file within the server, or searching at least one file within the server. *See, e.g., id.* at pg. 13, lines 2-8. The forms module may enable the wireless client device to view at least one application output associated with the at least one selected application action, wherein the output is formatted based on a user selection of one or

more fields associated with the at least one file. See, e.g., *id.* at pg. 23 line 1-pg. 26 line 20.

3. Claim 33

Another aspect of the invention relates to a wireless client device capable of communicating with at least one server having one or more applications thereon. In some embodiments the wireless client device comprises a views/folders module, a default and custom actions module, and a forms module. The views/folders module may enable the at least one wireless client device to display options associated with a selected application residing on the at least one server. See, e.g., *id.* at pg. 27, lines 7-13. The default and custom actions module may enable the at least one wireless client device to select at least one application action associated with the selected application to be executed on the at least one server. See, e.g., *id.* at pg. 28, lines 7-13. The application action may comprise one or more of one of opening at least one file within the server, closing at least one file within the server, editing at least one file within the server, or searching at least one file within the server. See, e.g., *id.* at pg. 13, lines 2-8. The forms module may enable the wireless client device to view at least one application output associated with the at least one selected application action, wherein the output is formatted based on a user selection of one or more fields associated with the at least one file. See, e.g., *id.* at pg. 23 line 1-pg. 26 line 20.

4. Claim 38

Another aspect of the invention relates to a storage medium for storing a machine readable code, the machine readable code being executable to enable a wireless client device to communicate with at least one server, having one or more applications residing thereon, according to the steps of: enabling the wireless client device to select an application residing on the at least one server (*see, e.g., id.* at pg. 12 line 19-pg. 13 line 8); enabling the wireless client device to select at least one application action associated with the selected application residing on the at least one server (*see, e.g., id.* at pg. 12 line 19-pg. 13 line 8); executing the at least one selected application action on the at least one server (*see, e.g., id.* at pg. 12, lines 19-21), the

application action comprising at least one of opening one or more of file within the server, closing at least one file within the server, editing at least one file within the server, or searching at least one file within the server (*see, e.g., id.* at pg. 13, lines 2-8); formatting at least one application output associated with the at least one selected application actions based on a profile of the wireless client device and a user selection of one or more fields associated with the at least one file (*see, e.g., id.* at pg. 31 line 15-pg. 32 line 2); and transmitting the formatted at least one application output to the wireless client device (*see, e.g., id.* at pg 12, lines 19-21).

B. DEPENDENT CLAIMS ARGUED SEPARATELY

1. Claims 24 and 41

In some embodiments, the profile of the wireless client device comprises at least one of a feature of the wireless client device or a device type of the wireless client device. *See, e.g., id.* at pg. 31 line 15-pg. 32 line 2.

VI. 37 C.F.R. § 41.37(c)(1)(vi) – GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL.

Claims 21, 22, 25-30, 32-36, 37-39, and 42-44 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,633,759 to Kobayashi ("Kobayashi") in view of U.S. Patent No. 6,052,735 to Ulrich *et al.* ("Ulrich"), and claims 24 and 41 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kobayashi in view of Ulrich, and in further view of U.S. Patent No. 6,308,061 to Criss *et al.* ("Criss"). These rejections constitute legal error, and should be reversed upon review.

VII. 37 C.F.R. § 41.37(c)(1)(vii) – ARGUMENT

The rejection of claims 21, 22, 25-30, 32-36, 37-39, and 42-44 based on the proposed combination of Kobayashi and Ulrich, and the rejection of claims 24 and 41 based on the proposed combination of Kobayashi, Ulrich, and Criss, constitute legal error at least because the Examiner has failed to present a *prima facie* case of unpatentability.

It is well established that “the examiner bears the initial burden, on review of the prior art or an any other ground, of presenting a *prima facie* case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992) (discussing *In re Piasecki*, 745 F.2d 1468, 1472, (Fed. Cir. 1984)). In the Office Action, the Examiner has failed to meet the requisite burden of establishing a *prima facie* case of obviousness at least for the reasons presented below.

Obviousness is a question of law based on the following underlying factual inquiries: “(a) the scope and content of the prior art; (b) the differences between the prior art and the claims at issue; (c) the level of ordinary skill in the art; and (d) objective evidence of nonobviousness.” *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 958 (Fed. Cir. 1986) (citing *Graham v. John Deere Co.*, 383 U.S. 1 (1966)). “Against this background, the obviousness or nonobviousness of the subject matter is determined.” *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966).

Moreover, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 985 (C.C.P.A. 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385 (C.C.P.A. 1970).

A. CLAIMS 21 AND 38 (and their dependent claims).

The rejection of claims 21 and 38 (and their dependent claims) based on the cited sections of Kobayashi and Ulrich is legally erroneous at least because the

Examiner has failed to present evidence demonstrating the *prima facie* obviousness of these claims. In particular, the Examiner has failed (1) to show that each and every feature of claims 21 and 38 is taught or suggested by Kobayashi and Ulrich, and (2) to provide evidence establishing that it would have been obvious to one of ordinary skill in the art to combine the teachings of Kobayashi and Ulrich in the manner proposed by the Examiner.

1. **The Examiner Has Not Demonstrated That Kobayashi And Ulrich Teach Or Suggest All Of The Features Of The Claimed Invention.**

The Examiner has not provided evidence that the proposed combination of Kobayashi and Ulrich teaches or suggests all of the features of claims 21 and 38. For example, claims 21 and 38 recite *inter alia* the following features, which are not taught or suggested in the sections of Kobayashi and Ulrich relied on by the Examiner:

...executing the at least one selected application action on the at least one server, **the application action comprising at least one or more of opening at least one file within the server, closing at least one file within the server, editing at least one file within the server, or searching at least one file within the server;** [and]

[] formatting at least one application output associated with the at least one selected application actions based on a profile of the wireless client device and a user selection of one or more fields associated with the at least one file....

The Examiner acknowledges that Kobayashi fails to teach or suggest these features. The Office Action, pp. 3 and 4. The Examiner alleges that Ulrich teaches formatting at least one application output associated with the at least one selected application action based on a profile of the wireless client device and a user selection of one or more fields associated with the at least one file at column 12, lines 57-65, and column 13, line 64-column 14, line 19. *Id.*

Generally, the sections of Ulrich relied on by the Examiner describe a system in which a user may request that a file attached to an email be downloaded to a mobile device through a touchscreen provided on the mobile device. Column 13, ll. 31-36. In response to this request, a synchronization monitor provided on a server manages a

download of the requested file from the server to the mobile device. Column 13, l. 57-c. 14, l. 31. Ulrich teaches that in some instances a synchronization interface component on the server converts the electronic format of the file to some predetermined file format prior to the download. Column 14, ll. 7-19. This conversion may be based on a user profile previously configured by the user. *Id.*

In the Office Action, the Examiner alleges that in Ulrich the file downloaded to the mobile device constitutes the “at least one application output” recited in claims 21 and 38. Page 4. However, the claim element, as a whole, recites an “application action comprising at least one or more of ***opening at least one file within the server, closing at least one file within the server, editing at least one file within the server, or searching at least one file within the server***; [and]... formatting at least one application output associated with the at least one selected application actions based on a profile of the wireless client device.” The Examiner acknowledges that claims 21 and 38 require the “at least one application output [to be] associated with the at least one selected application actions,” and contends that the file download is associated with an “open or add” application action. *Id.* However, this is an incorrect and unsupported characterization of the teachings of Ulrich.

In actuality, the actions taken by the server in Ulrich cannot be construed as including one of the “application actions” recited in claims 21 and 38. Ulrich does not teach that the server executes an action that includes ***opening*** the file to be downloaded (or closing, or editing, or searching the file). Other than transmission of the file, the only action disclosed as being performed by the server of Ulrich on the downloaded file is the possible conversion of file format, not opening the file. Column 14, ll. 7-31. Therefore, contrary to the contentions of the Examiner, Ulrich does not teach or suggest formatting at least one application output associated with the at least one selected application action based on a profile of the wireless client device and a user selection of one or more fields associated with the at least one file at least because the alleged “application output” of Ulrich (*i.e.*, the downloaded file) is not “associated with the at least one application action” recited in claims 21 and 38, which both recite

the execution of at least one of these application actions on the server, rather than the client.

This is an important distinction because the “application actions” expressly recited in claims 21 and 38 as being performed “within the server” (opening, closing, editing, or searching) are actions associated with accessing the content within a file. As such, the formatting of the “application output” recited in claims 21 constitutes the formatting of information generated through server-side accessing and/or processing of **content** within the file that is interacted with on the server by the “application action.” In contrast, the formatting taught by Ulrich is a formatting of the electronic format of a file, and not the underlying content. To access the content of the file downloaded in the system of Ulrich (e.g., through an opening, closing, editing, or searching action), the user must perform this processing on the mobile device after the file has been downloaded. This places a processing and/or storage load on the mobile device that is not experienced by the “wireless client device” recited in claims 21 and 38.

Therefore, the specific combination of Kobayashi and Ulrich proposed by the Examiner, in which reformatting of electronic formats of files in Ulrich is substituted wholesale into the teachings of Kobayashi, fails to teach or suggest at least the features of claims 21 and 38 reproduced above. Further, the Examiner has not proposed any other combination of Kobayashi and Ulrich, and has not provided any evidence supporting the obviousness of any other combination of these references. Accordingly, the rejection of claims 21 and 38 (and their dependent claims) based on the combination of Kobayashi and Ulrich proposed by the Examiner constitutes legal error and must be reversed.

2. The Examiner Has Not Established That It Would Have Been Obvious To Combine Kobayashi And Ulrich In The Proposed Manner.

The rejection of claims 21 and 38 based on the proposed combination of Kobayashi and Ulrich constitutes legal error at least because the Examiner has not provided any evidence or reasoning that properly supports the legal conclusion of the alleged obviousness of the proposed combination.

The proper analysis involved in the legal determination of “obviousness” is flexible, and provides for the use of common sense in applying the references to the claimed invention. *KSR v. Teleflex, Inc.*, 127 S.Ct. 1727, 1739 and 1742. However, determinations of obviousness cannot be sustained on conclusory statements, but require articulated reasoning that provides a “rational underpinning” supporting the legal conclusion of obviousness. *Id.* at 1740-1741.

In proposing the combination of Kobayashi, the Examiner made the following statement:

It would have been obvious to... combine the references to properly forward attachment [sic] to the destination with compatibility [sic].” The Office Action, p. 4.

Under *KSR*, an express motivation to combine or modify references is not necessary for a conclusion of obviousness. However, at least some evidence of obviousness is required. *Id.* at 1740-1741. In the present case, the alleged motivation reproduced above is the only alleged basis that the Examiner has provided for the proposed combination. Thus, in this case the correct focus in addressing the alleged obviousness of the proposed combination is on whether there is sufficient evidence to support the Examiner’s allegation regarding motivation.

The portions of Kobayashi cited in the rejection appear to describe a system in which software operating on a personal computer (e.g., a laptop) is manipulated by inputs to a mobile device (e.g., a cell phone) in communication with a personal computer. The personal computer, in turn, transmits outputs from the manipulated software to the mobile device that enable the mobile device to essentially provide a real-time display of information that corresponds to the display generated by the software for the personal computer as the software is manipulated. See, e.g., the Office Action, pp. 2 and 3, and Kobayashi, c. 8, l. 29-c. 9, l. 13. In other words, Kobayashi teaches the **formatting of content** within files to facilitate display on mobile devices of the content initially intended for display on the personal computer. The only data transmitted from the personal computer in Kobayashi to the mobile device is “display data” (also referred

to as “screen data”), not attachment files for access and manipulation on the mobile device.

By contrast, the sections of Ulrich relied on by the Examiner are relevant to forwarding emails with attached files to a mobile device, as the Examiner acknowledges in the stated motivation. Ulrich teaches that in order for the content of the files to be accessed and/or manipulated on the mobile device, the file format of the attached files should be converted to a file format supported by the mobile device. Column 13, l. 44-c. 14, l. 31.

The Examiner alleges that promoting the compatibility of attachments with mobile devices would have motivated one of ordinary skill in the art to incorporate the teachings of Ulrich into the system of Kobayashi. In reality, this type of compatibility is irrelevant in the system of Kobayashi because in Kobayashi all of the processing of the file in order to access content is performed on the personal computer, not the mobile device, and only display data is transmitted to the mobile device. The electronic format of attachments would not be reformatted for compatibility because attachment files are not forwarded to the mobile device in Kobayashi. One of ordinary skill in the art would not have been motivated to incorporate the file reformatting of Ulrich into the system of Kobayashi to promote compatibility of attachment files with a mobile device at least because the system of Kobayashi does not involve the transmission of attachment files to a mobile device for processing on the mobile device. Thus, the motivation expressly stated by the Examiner (*i.e.*, “to properly forward attachment [sic] to the destination with compatibility [sic]”) constitutes legal error. The Examiner has not articulated any other grounds for supporting the alleged obviousness of the proposed combination of Kobayashi with Ulrich. For at least this reason the rejection of claims 21 and 38 (and their dependent claims) constitutes legal error and must be reversed.

B. CLAIMS 28 AND 33 (and their dependent claims).

The rejection of claims 28 and 33 (and their dependent claims) based on the cited sections of Kobayashi and Ulrich is legally erroneous at least because the

Examiner has failed to present evidence demonstrating the *prima facie* obviousness of these claims. In particular, the Examiner has failed (1) to show that each and every feature of claims 28 and 33 is taught or suggested by Kobayashi and Ulrich, and (2) to provide evidence establishing that it would have been obvious to one of ordinary skill in the art to combine the teachings of Kobayashi and Ulrich in the manner proposed by the Examiner.

1. The Examiner Has Not Demonstrated That Kobayashi And Ulrich Teach Or Suggest All Of The Features Of The Claimed Invention.

The Examiner has not provided evidence that the proposed combination of Kobayashi and Ulrich teaches or suggests all of the features of claims 28 and 33. For example, claims 28 and 33 recite *inter alia* the following features, which are not taught or suggested in the sections of Kobayashi and Ulrich relied on by the Examiner:

... the application action comprising at least one or more of opening at least one file within the server, closing at least one file within the server, editing at least one file within the server, or and searching at least one file within the server; and

a forms module that enables the wireless client device to view at least one application output associated with the at least one selected application action, wherein the output is formatted based on a user selection, made on the at least one wireless client device, of one or more fields associated with the at least one file.

The Examiner acknowledges Kobayashi does not teach or suggest formatting at least one application output associated with the at least one selected application action based on a profile of the wireless client device and a user selection of one or more fields associated with the at least one file. The Office Action, p. 5. The Examiner alleges that Ulrich addresses this deficiency of Kobayashi. *Id.* As Appellants demonstrated above, the sections of Ulrich relied on in the Office Action do not adequately address the acknowledged deficiency of Kobayashi. For instance, the sections of Ulrich cited by the Examiner do not teach or suggest formatting at least one application output associated with the at least one selected application action based on a profile of the wireless client device and a user selection of one or more fields associated with the at least one file at least because the alleged "application output" of

Ulrich (*i.e.*, the downloaded file) is not “associated with the at least one application action” recited in claims 28 and 33. Thus, the proposed combination of Kobayashi and Ulrich does not teach or suggest the features of claims 28 and 33 presented above. For at least this reason the rejection of claims 28 and 33, and their dependent claims, based on the proposed combination of Kobayashi and Ulrich is legally erroneous and must be reversed.

2. The Examiner Has Not Established That It Would Have Been Obvious To Combine Kobayashi And Ulrich In The Proposed Manner.

The rejection of claims 28 and 33 based on the proposed combination of Kobayashi and Ulrich constitutes legal error at least because, as Appellants demonstrated above, the Examiner has not provided any evidence or reasoning that properly supports the legal conclusion of the alleged obviousness of the proposed combination. For at least this reason the rejection of claims 28 and 33, and their dependent claims, based on the proposed combination of Kobayashi and Ulrich is legally erroneous and must be reversed.

C. CLAIMS 24 AND 41

The rejection of claims 24 and 41 constitutes legal error. For example, the standing rejection of claims 24 and 41, which is based on a proposed combination of Kobayashi and Criss, is improper because the cited portions of Kobayashi and Criss (1) do not teach or suggest all of the features of the claimed invention, and (2) Criss is non-analogous art.

1. The Examiner Has Not Demonstrated That Kobayashi, Ulrich, And Criss Teach Or Suggest All Of The Features Of The Claimed Invention.

To properly reject claims 24 and/or 41, the Examiner must demonstrate that cited portions of Kobayashi, Ulrich, and Criss teach or suggest each and every feature of the claimed invention. Kobayashi, Ulrich, and Criss fail to teach or suggest, for example,

the features of **wherein the profile of the wireless client device comprises at least one of a feature of the wireless client device or a device type of the wireless client device**, as is recited *inter alia* in each of claims 24 and 41.

The Examiner acknowledges that Kobayashi fails to teach or suggest this feature, but alleges that Criss teaches “that the version number, and capacity, etc. of [sic] wireless device are transmit [sic] to a host computer for [sic] keep up with the upgrade of the wireless device.” The Office Action, p. 7. Whether or not Criss teaches that the “version number” of software loaded onto the wireless device (*e.g.*, at c. 12, ll. 55-62) is irrelevant, as the version number of software loaded onto a wireless device is neither a **feature of the wireless client device** nor a **device type**. The allegation of the Examiner that Criss teaches transmitting a “capacity, etc.” of a wireless device does not seem to be supported by the disclosure of Criss (which appears to teach only transmission of a current version of software). Further, the Examiner has not pointed to any specific passage within Criss as supporting this allegation. As such, the cited sections of Kobayashi and Criss do not teach or suggest **the profile of the wireless client device comprises at least one of a feature of the wireless client device or a device type of the wireless client device**. For at least this reason the rejections of claims 24 and 41 based on the cited sections of Kobayashi, Ulrich, and Criss are erroneous and must be reversed.

2. Criss is non-analogous art for the purposes of the instant application.

The first factor in deciding whether a claim is obvious in light of the prior art is determining “the scope and content of the prior art.” *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 958, 1 U.S.P.Q.2d 1196, 1197 (Fed. Cir. 1986) (citing *Graham v. John Deere Co.*, 383 U.S. 1 (1966)). This includes determining what constitutes analogous art to the claimed invention.

The Examiner’s reliance on Criss for the rejection of claims 24 and 41 is improper as this reference is non-analogous art to Appellant’s claimed invention.

A two-step test has been developed to determine whether a particular reference is within the appropriate scope of the prior art. First, it must be determined whether a particular reference is “within the field of the inventor’s endeavor.” Second, assuming the reference is outside that field, it must be determined whether the reference is “reasonably pertinent to the particular problem with which the inventor was involved.” *In re Deminski*, 796 F.2d 436, 230 U.S.P.Q. (BNA) 313, 315 (Fed. Cir. 1986).

a. *Criss is outside the inventor’s field of endeavor.*

Criss is outside the field of the inventor’s endeavor for at least the reason that Criss is not related to the *relevant* field of endeavor. The inventor’s field of endeavor (for claims 24 and 41) relates to wireless device access and, in particular, to enabling users to access server-based information using mobile devices over wireless data networks. See the specification, p. 1, ll. 4-7.

Criss, by contrast, describes a system of upgrading software on mobile devices based on a determination as to whether such an upgrade is necessary. See, e.g., Criss, c. 2, ll. 50-54. This field of endeavor is not within the inventor’s field of endeavor.

b. *Criss is not reasonably pertinent to the particular problem(s) with which Appellant was involved.*

Since Criss is outside the inventor’s field of endeavor, the inquiry becomes whether this reference is reasonably pertinent to the particular problem(s) with which Appellant was involved.

A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would commend itself to an inventor’s attention in considering his problem. Thus, the purposes of both the invention and the prior art are important in determining whether the reference is reasonably pertinent to the problem the inventor attempts to solve. If a reference disclosure has **the same purpose** as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection. An inventor may well have been motivated to consider the reference when making his invention. If it is directed to a different purpose,

the inventor would accordingly have had less motivation or occasion to consider it. *In re Clay*, 966 F.2d 656, 23 U.S.P.Q. 2d (BNA) 1058 (Fed. Cir. 1992) (emphasis added).

Criss is not reasonable pertinent to the particular problem(s) with which Appellant was involved. These problems include, for example, sending and receiving messages, alerts, pages, notification, and other forms of information to and from mobile devices such that the information can be viewed on a mobile device, prompt execution of commands on a server in response to selection of such commands on a mobile device, customization of information delivered to a mobile device, *etc.*

In contrast, the problems addressed in Criss are related to whether or not software has previously been upgraded so that duplicative upgrades are not implemented, thereby wasting system resources and time. *See, e.g., Criss*, c. 2, ll. 21-39.

The Examiner cites no evidence that a person having ordinary skill in the art would reasonably have expected to solve the problem(s) associated with enabling users to access server-based information using mobile devices over wireless data networks by implementing design concepts conceived for upgrading software on mobile devices to avoid duplicative upgrading, as are disclosed in Criss. As such, there would be no reason one of ordinary skill in the art would look to the diverse field of Criss absent hindsight.

Patent examination is necessarily conducted by hindsight, with complete knowledge of the applicant's invention, and the courts have recognized the subjective aspects of determining whether an inventor would be reasonably motivated to go to the field in which the examiner found the reference, in order to solve the problem confronting the inventor... [I]t is...in other words, common sense...in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor...The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. *In re Oetiker*,

977 F.2d 1443, 24 U.S.P.Q. 2d (BNA) 1443 (Fed. Cir. 1992).

Application of the proper two-step legal analysis frequently demonstrates that references, which might appear relevant to (or have something in common with) a claimed invention, are not analogous and therefore may not be properly considered. The Federal Circuit has frequently confirmed this. For example, it has held that the art of petroleum extraction is not analogous to the art of petroleum storage despite both being in the petroleum industry. *In re Clay*, 966 F.2d 656, 659-60 (Fed. Cir. 1992). Fasteners for garments are not analogous to fasteners for a hose clamp. *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992). Paper stapling is not analogous to surgical stapling. *U.S. Surgical Corp. v. Hospital Prods. Int'l Pty., Ltd.*, 701 F. Supp. 314, 334 (D. Conn. 1988). Single in-line memory modules (SIMMs) for an industrial controller is not analogous to SIMMs for personal computers. *Wang Labs., Inc. v. Toshiba Corp.*, 993 F.2d 858, 864 (Fed. Cir. 1992). Railway car brakes are not analogous to automotive vehicle brakes. *SAB Industri AB v. The Bendix Corp.*, 199 USPQ 95, (E.D. Va. 1978).

For at least the foregoing reasons, it is clear that the Examiner has not proven an essential element of the obviousness test, *i.e.*, that Criss is within the scope and content of the prior art. As a result, Criss cannot be properly considered in an obviousness analysis. "The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness." *In re Oetiker*, 977 F.2d 1443, 1447, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992). This reference therefore cannot be relied upon to prove obviousness of Appellant's invention as claimed in claims 24 and 41. Accordingly, the rejection of claims 24 and 41 under 35 U.S.C. § 103(a) should therefore be reversed.

VIII. 37 C.F.R. §41.37(c)(1)(viii) - CLAIMS APPENDIX

Appendix A: The pending claims are attached in Appendix A.

IX. 37 C.F.R. §41.37(c)(1)(ix) - EVIDENCE APPENDIX

Appendix B: (None)

X. 37 C.F.R. §41.37(c)(1)(x) - RELATED PROCEEDINGS INDEX

Appendix C: (None)

CONCLUSION

For at least the foregoing reasons, Appellants respectfully request that the rejection of each of claims 21, 22, 24-30, 32-39, and 41-44 be reversed.

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APPENDIX A

CLAIMS

1-20. (Cancelled)

21. **(Previously Presented)** A method for enabling a wireless client device to communicate with at least one server having one or more applications residing thereon, the method comprising the steps of:

enabling the wireless client device to select an application residing on the at least one server;

enabling the wireless client device to select at least one application action associated with the selected application residing on the at least one server;

executing the at least one selected application action on the at least one server, the application action comprising one or more of opening at least one file within the server, closing at least one file within the server, editing at least one file within the server, or searching at least one file within the server;

formatting at least one application output associated with the at least one selected application actions based on a profile of the wireless client device and a user selection of one or more fields associated with the at least one file; and

transmitting the formatted at least one application output to the wireless client device.

22. **(Previously Presented)** The method of claim 21 wherein the selected application comprises at least one of an email application, a calendar application, a personal directory application, or a public directory application.

23. **(Cancelled)**

24. **(Previously Presented)** The method of claim 21 wherein the profile of the wireless client device comprises one or both of at least one feature of the wireless client device or a device type of the wireless client device.

25. **(Previously Presented)** The method of claim 24 wherein the profile of the wireless client device comprises at least one feature of the wireless device, and wherein the at least one feature of the wireless client device comprises one or both of an input interface feature or a data processing feature.

26. **(Previously Presented)** The method of claim 21 wherein formatting the at least one application output comprises altering an object or artifact contained in the at least one application output separate from other information included in the at least one application output, the object or artifact being altered to reduce an amount of information that the object or artifact contains.

27. **(Previously Presented)** The method of claim 24 wherein the profile of the wireless client device comprises a device type, and wherein the device type of the wireless client

device comprises one or more of a data-capable wireless phone, an interactive pager, or a personal digital assistant.

28. **(Previously Presented)** A wireless communication system, the system comprising:

at least one server having one or more applications thereon; and

at least one wireless client device comprising:

a views/folders module that enables the at least one wireless client device to display options associated with a selected application residing on the at least one server;

a default and custom actions module that enables the at least one wireless client device to select at least one application action associated with the selected application to be executed on the at least one server, the application action comprising one or more of opening at least one file within the server, closing at least one file within the server, editing at least one file within the server, or searching at least one file within the server; and

a forms module that enables the wireless client device to view at least one application output associated with the at least one selected application action, wherein the output is formatted based on a user selection, made on the at least one wireless client device, of one or more fields associated with the at least one file.

29. **(Previously Presented)** The system of claim 28 further comprising a customization module that enables the at least one wireless client device to customize at least one view of the at least one application output.

30. **(Previously Presented)** The system of claim 29 wherein the customization module further enables the at least one wireless client device to customize at least one of a display language, a time zone, a date format, and a font format.

31. **(Cancelled)**

32. **(Previously Presented)** The system of claim 28, wherein the selected application comprises at least one of an email application, a calendar application, and a public directory application.

33. **(Previously Presented)** A wireless client device capable of communicating with at least one server having one or more applications thereon, the wireless client device comprising:

a views/folders module that enables the wireless client device to display options associated with a selected application residing on the at least one server;

a default and custom actions module that enables the wireless client device to select at least one application action associated with the selected application to be executed on the at least one server the application action comprising one or more of opening at least one file within the server closing at least one file within the server, editing at least one file within the server, or searching at least one file within the server; and

a forms module that enables the wireless client device to view at least one application output associated with the at least one selected application action, wherein

the output is formatted based on a user selection, made on the at least one wireless client device, of one or more fields associated with the at least one file.

34. **(Previously Presented)** The wireless client device of claim 33 further comprising a customization module that enables the wireless client device to customize at least one view of the at least one application output.

35. **(Previously Presented)** The wireless client device of claim 34 wherein the customization module further enables the wireless client device to customize at least one of a display language, a time zone, a date format, and a font format.

36. **(Cancelled)**

37. **(Previously Presented)** The wireless device of claim 33 wherein the selected application comprises at least one of an email application, a calendar application, a personal directory application and a public directory application.

38. **(Previously Presented)** A storage medium for storing a machine readable code, the machine readable code being executable to enable a wireless client device to communicate with at least one server, having one or more applications residing thereon, according to the steps of:

enabling the wireless client device to select an application residing on the at least one server;

enabling the wireless client device to select at least one application action associated with the selected application residing on the at least one server;

executing the at least one selected application action on the at least one server, the application action comprising one or more of opening at least one file within the server, closing at least one file within the server, editing at least one file within the server or searching at least one file within the server;

formatting at least one application output associated with the at least one selected application action based on a profile of the wireless client device and a user selection of one or more fields associated with the at least one file; and

transmitting the formatted at least one application output to the wireless client device.

39. **(Previously Presented)** The storage medium of claim 38 wherein the selected application comprises at least one of an email application, a calendar application, or a public directory application.

40. **(Cancelled)**

41. **(Previously Presented)** The storage medium of claim 38 wherein the profile of the wireless client device comprises one or both of at least one feature of the wireless client device or a device type of the wireless client device.

42. **(Previously Presented)** The storage medium of claim 41 wherein the profile of the wireless client device comprises at least one feature of the wireless client device, and

wherein the at least one feature of the wireless client device comprises one or more of an input interface feature or a data processing feature.

43. **(Previously Presented)** The storage medium of claim 38 wherein formatting the at least one application output comprises altering object or artifact contained in the at least one application output separately from other information included in the at least one application output, the object or artifact being altered to reduce an amount of information that the object or artifact contains.

44. **(Previously Presented)** The storage medium of claim 41 wherein the profile of the wireless client device comprises a device type, and wherein the device type of the wireless client device comprises at least one of a data-capable wireless phone, an interactive pager, and a personal digital assistant.

APPENDIX B

EVIDENCE APPENDIX

NONE

APPENDIX C

RELATED PROCEEDINGS INDEX

NONE